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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,314	12/05/2000	Allan S. Gelb	31611.0004	8078

7590 08/01/2002

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EXAMINER

KRISHNAMURTHY, RAMESH

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/730,314

Applicant(s)

GELB ET AL.

Examiner

Ramesh Krishnamurthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 40 is/are pending in the application.
- 4a) Of the above claim(s) 1 - 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28 - 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

This office action is responsive to communications filed on 06/26/02.

Claims 28 – 40 are pending.

1. Claims 1 – 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 28 – 33, 35 and 38 – 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elmquist et al. in view of Baker, Jr..

Elmquist et al. discloses a Heart pacemaker system comprising an electrode having layers with a first layer deposited on a substrate comprising platinum or titanium, with the first layer comprising a carbide, nitride or carbon-nitride of at least one of the

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metals – titanium, vanadium, zirconium, niobium, molybdenum, hafnium, tantalum or tungsten.

However, Elmquist et al. fails to disclose a surface layer that comprises iridium. The patent to Baker, Jr. discloses that it is known in the art to use of a surface layer (that is in contact with the bodily humors) that comprises iridium since such a layer exhibits lower polarization thereby making available more energy for tissue stimulation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the electrode in Elmquist et al. With a surface layer that comprises iridium for the purpose of obtaining lower polarization thereby making available more energy for tissue stimulation, as recognized by Baker, Jr.

Elmquist et al. indicate that the first layer could be deposited by means of physical vapor deposition which here is taken to include the known methods of DC and RF sputtering. The use of an argon rich atmosphere for sputtering merely provides an inert gas atmosphere whose use is known in the art. The use of a nitrogen rich atmosphere for forming the first layer would allow the nitration of the first layer providing the layer with good conductivity.

5. Claims 34, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elmquist et al. in view of Baker, Jr. as applied to claims 28 – 33, 35 and 38 – 40 above, and further in view of Lee et al.

The method according to the combination of Elmquist et al. and Baker, Jr. anticipates the claimed method with the exception of including the application of an RF bias. The patent to lee et al. discloses that it is known in the art to apply an RF bias to

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the substrate to lessen the cusping that occurs during the manufacture and thereby improve the planarization in a multi-layer structure. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used RF bias to the substrate in the method according to the combination of Elmquist et al. and Baker, Jr. for the purpose of lessening the cusping that occurs during the manufacture and to thereby improve the planarization in a multi-layer structure as recognized by le et al.

Regarding claim 37, it is noted that the selective application of an RF bias for a certain time period is merely a design choice over those aspects of the method according to the combination of Elmquist et al, Baker Jr. and lee et al, in that it neither solves any stated problem nor provides any new and/or unexpected result.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patents to Bussard et al., Szilagyi, Phillips, Jr. et al and Yamasaki disclose electrodes that are implantable in bodies. Maniar et al., Yamazaki et al., Munshi et al., Enomoto et al. and Park et al. disclose various processes for depositing layers on a substrate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh Krishnamurthy whose telephone number is (703) 305 - 5295. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Buiz, can be reached on (703) 308 - 0871. The fax phone number for the organization where this application or proceeding is assigned is (703) 308 - 7765.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 - 0861.

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Ramesh Krishnamurthy, Ph. D., PE
Examiner
Art Unit 3753
July 29, 2002



Michael Powell Buig
Supervisory Patent Examiner
US Patent & Trademark Office

07/29/02